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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Tetsuo Nakata

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02/23/2006

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812,551

Applicant(s)

NAKATA ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/9/2005 & 12/8/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/9/2005 has been entered.

### ***Response to Amendment***

2. Applicant's amendment with Remarks received on 11/9/2005 is acknowledged and entered. Claims 1, 7-13 are amended. Currently claims 1 and 3-13 are pending for examination.

### ***Response to Arguments***

3. Applicant's arguments with respect to currently amended claims 1, 3-13 have been considered but are moot in view of the new ground(s) of rejection.

4. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the

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references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, and 3-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Erickson (US Patent 5,765,152).

Regarding claim 1, Erickson discloses a sales method for selling a literary work, comprising:

selling units of rights based on a copyright of the literary work to a purchaser using a computer based sales device to communicate over a communication network with the purchaser at a computer based purchaser device (see at least col.2, line 60-col.3, line 44, col.6, lines 36-49, col.7, line 26-col.8, line 22, col.12, lines 56-58, col.19, line 60-col.20, line 3, col.21, line 25-col.27, line 12, disclose a license transaction for literary work involving selling auxiliary permissions which correspond to selling units of rights in the form of viewing rights, copying rights, editing rights, etc., for a literary work or any other copyrighted work using a computer to communicate this transaction from a server and execution of license transaction results in selling auxiliary permissions that is

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units of rights of a copyrighted literary or any other work the in the form of auxiliary permissions to a purchaser and collecting payment online for the sold units of rights.);

associating information about the purchaser's units of rights to the literary work (see at least col.7, lines 26-30, col.13, lines 33 and col.21, line 25-col.27, line 12 which disclose that information about minimum and auxiliary permissions [purchaser's units of rights] is appended to the literary work) and information about a purchaser that has purchased said literary work (see at least col.13, lines 16-25 which discloses that the document being purchased includes information about the users of that information, such as usage information, identity and or location of the user, etc.) ; and

publicizing said associating information via the network (see at least col.20, line 47-col.23, line 8, figs 7a-7h and col.21, line 25-col.27, line 12 disclose and display the auxiliary permissions, that is units of right granted to the purchaser),

Regarding claim 3, Erickson discloses that in the sales method according to claim 1 the information about the purchaser is provided per units of the sold rights (see at least col.20, line 47-col.23, line 8 and figs 7a-7h and col.21, line 25-col.27, line 12 disclose and display the auxiliary permissions, that is units of right granted to the purchaser. Fee is charged as per the units of permissions, such as viewing, copying, editing is bought.).

Regarding claim 4, Erickson discloses that the sales method according to claim 1, further comprises notifying a seller of the literary work of rights based on the

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copyright corresponding to a type of the literary work; and obtaining from the seller information about the right to be sold, from the notified rights (see at least col.17, lines 14-45).

Regarding claims 5/6, Erickson discloses that the information about the purchaser is provided to an arbitrary person/ after payment of a purchase price is confirmed (see at least col.24, lines 63-67, "...Request human intervention.....", which teaches that during the license transaction the purchaser's information is passed on to a human operator).

Regarding claims 7-13, their limitations are closely parallel to the limitations of claims 1, 3-6 are therefore analyzed and rejected on the basis of same rationale.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Publication 2003/0088517 A1 discloses providing legal license agreement for accessing private information on www (see at least Abstract)

(ii) US Patent 6,959,289 to James et al. discloses establishing legal license and limitations for accessing and using the intellectual property information on www (see at least Abstract).

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(iii) US Patent 6,789,197 B1 to Saito discloses an apparatus for displaying, storing, copying, editing or transferring digital data, and protecting digital data copyrights (see at least Abstract and col.1, lines 10-13).

(iv) US Publication 2002/0107809 A1 discloses method and system for managing licensing data using client/server architecture (see at least Abstract).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG/2/15/2006